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Case 6887

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
: Britta DAUME :
: Serial No.: 09/491,841 :
: Filed: August 23, 1999 :
: For: A DEVICE FOR CONTACTING IN :
: PARTICULAR ELONGATED, :
: ILLUSTRATIVELY SUBSTANTIALLY :
: CYLINDRICAL BODIES SUCH AS :
: CABLES OR PIPES/TUBES :

REPLY BRIEF

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REPLY BRIEF

Honorable Commissioner of Patents
and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The paper is responsive to the Examiner's Answer mailed
January 28, 2004 and as provided under 37 CFR §1.193(b)(1):

1. On pages 4 and 5 of the Examiner's Answer, the examiner
responds to appellant's argument that claim 1 and 13 cannot be
indefinite.

The examiner states the language in claims 1 and 13 is contrary
to the written description therefore the claims are indefinite under
section 112, second paragraph.

The examiner states that claims cannot be "read in a vacuum" yet she urges the Board to ignore relevant portions of the written description as well as the description in the drawings. In essence, the examiner argues that because the specification at page 17, line 18 states "the base structure 4 ... comprises a band shaped metal contact element 10" it cannot be "attached to" the contact element as recited in claims 1 and 13. The examiner fails to consider the written description as a whole which, as shown in figures 1 and 2 and as described on page 18, lines 4-7, describes a contact element imbedded into the base structure. The contact element is attached to the base structure. Also see the other figures and description which show other methods of how the contact element is attached to the base structure.

2. On page 5 of the Examiner's Answer, the examiner states claim 8 is contradictory and therefore indefinite. Elected species II (figures 5 and 6) is covered by independent claim 13. Claim 8 depends from generic claim 1 and claims an eight embodiment of the invention. See appellant's Appeal Brief at page 12. Claim 8 is not contradictory.

3. On page 5 of the Examiner's Answer, the examiner states claims 24, 25 and 26 confuse the relationship between the base 4, the contact element 10 and the elastic part 22 of the base.

Claim 24 states the base structure 4 includes an elastic part 22 having a surface coextensive with the base interior surface and is adapted for connection to the contact element. Corresponding figure 2 illustrates elastic part 22 in relation to the base structure 4 and page 18, lines 1-7 of the written description also describe these elements. The examiner does not rebut this clear, unambiguous disclosure. Instead, the examiner's asserts the word "comprises" at page 17 line 18 of the written description confuses the relationship between the base, the contact element and the elastic part recited in claims 24, 25 and 26. As is apparent from the written description and drawings, the relation between these elements cannot be confusing.

Regarding claim 25, it is noted appellant has requested in Section V of their Brief that the Board instruct the examiner to correct a typographical error in this claim and change "elastic sleeve part" to "elastic part". Claim 25 states the elastic part 22 is constructed from elastic material and the contact element is either embedded in the elastic part 22 or secured to an exterior surface of the elastic part 22. Attention is directed the written description on page 18 lines 4-7, page 21, lines 16-28 and page 22, lines 1-8 together with the corresponding figures.

Claim 26 states the elastic part is a thermoplastic elastomer. Attention is directed to pate 10, lines 22-27, page 11, lines 1-2 which provides a clear description of what a thermoplastic elastomer is.

4. On page 5 of the Examiner's Answer, the examiner responds to appellant's argument that Ellinwood fails to disclose sealing lips as recited in claims 1 and 13, subparagraph (b) and therefore the rejection under Section 102(b) is improper.

The examiner now concedes that Ellinwood does not provide explicit disclosure of any sealing function or sealing lips. The examiner maintains a rejection under Section 102(b) is fully met by Ellinwood because a seal is "merely something that closes or fastens tightly or securely" and the tubular cushion 13 of Ellinwood is "tight against structure A". The examiner states applicant's description regarding the claimed sealing lips is not relevant because applicant did not claim these "requirements".

The definition provided by the examiner for the claimed sealing lips is overly broad, unreasonable and not consistent with applicant's disclosure. As noted in applicant's Appeal Brief at page 16, claims are to be construed in light of the totality of applicant's written description. If sealing lip were "merely something that closes or fastens tightly or securely" as stated by the examiner, then all clamps or support clips are seals. This is plainly not the case. A clamp cannot seal something merely because it is "tight against it". The support clip of Ellinwood provides a cushion material 13 for the stated purpose of preventing displacement of the conduit and dampening vibration. There is no disclosure of a sealing function as claimed.

5. On page 6, line 12-20 of the Examiner's Answer, the examiner responds to appellant's argument that the examiner has failed to provide *prima facie* obviousness regarding claim 23.

The examiner now states a second connection may be added to Ellinwood because doing so would "guard against failure of the first connection". However, nothing in Ellinwood suggests a failure of the first connection is likely to occur nor does the examiner explain why such a failure would be expected. Applicant respectfully maintains the rejection is improper.

The Seventh Circuit decision cited in the Examiner's Answer is not relevant. That decision found held the evidence did not support a finding the combination of old parts resulted in a synergistic combination. Appellant in this appeal is not relying on a synergistic combination to obviate the rejection. Rather, the examiner in this case has failed to provide *prima facie* obviousness.

6. On page 6, line 21-27 and page 7, lines 1-2 of the Examiner's Answer, the examiner responds to appellant's argument that the examiner has failed to provide *prima facie* obviousness regarding claim 26.

The examiner states the needs and properties for the cushion in provide motivation for use of TPE. However, the "needs and properties" of Ellinwood are cushioning and vibration damping. The claimed device does not provide a TPE for cushioning or vibration

damping nor has the examiner provided any evidence that a TPE material is adapted to provide cushioning or vibration damping. Applicant respectfully asserts there is no prior art suggestion for providing a TPE material as claimed for the cushioning material of Ellinwood.

7. On page 7, line 21-27 of the Examiner's Answer, the examiner responds to appellant's argument that the examiner has failed to provide *prima facie* obviousness regarding claim 30.

The examiner now states the combination of Ellinwood and Tinnerman `627 is suggested because it will enable the screw to be attached to one bracket prior to final attachment which enables for easier assembly and reduces the chances of loosening screws. The examiner concedes the proposed modification is more complex.

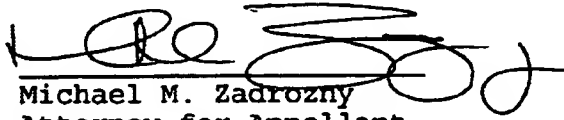
Ellinwood is a conduit support clip having a simple borehole through which a screw passes to secure the conduit to a wall. Tinnerman `627 does not secure a conduit to a wall. Tinnerman `627 secures an electrical ground wire to a conduit. A clamp for attachment to a wall does not share any functional requirement with a clamp for attaching a ground wire. There is no need in Ellinwood to screw one bracket prior to "final attachment". For what purpose? Nothing in Tinnerman `627 states the screw connection "reduces the chances of loosening screws". Adding the nut device shown in figure 2 of Tinnerman `627 to Ellinwood only serves to interfere when the device is attached to a support wall. In what way will the assembly

be "easier"? The proposed modification only complicates the efficient design of Ellinwood. It is respectfully asserted the proposed modification is based upon hindsight reconstruction.

In view of the above, appellant respectfully submits the reasons provided in the Examiner's Answer are incorrect and/or improper. It is requested the final rejection of the pending claims be reversed in all respects.

Respectfully Submitted,

Date: 3/29/04


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